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In re Application of
Christoffer Bro et al
Serial No.: 10/613,219
Filed: July 7, 2003
Attorney Docket No.: BRO-1

PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed June 27, 2007, requesting withdrawal of the Finality of the Office action mailed February 27, 2007.

BACKGROUND

A review of the relevant file history shows that the examiner mailed a non-Final Office action to applicants on May 22, 2006, addressing claims 1-6 and 8-12. (In response to a previous Office action applicants had amended claim 1 and canceled claim 7.) The examiner rejected claims 1, 4 and 9-11 under 35 U.S.C. 112, second paragraph as indefinite for various reasons and noted that this was a new rejection not necessitated by applicants' amendments. Claims 1-6 and 8-12 were rejected under 35 U.S.C. 112, first paragraph as (1) lacking written description, and (2) enablement, in the specification and noted that these were also new rejections not necessitated by applicants' amendments. Claims 1-6 and 8-12 were also rejected under 35 U.S.C. 102(e) as anticipated by Weinstock et al.

Applicants replied on November 22, 2006, amending claims 1-2, 4-6, and 8-12, canceling claim 3, and adding claims 13-25. Applicants replied to all of the grounds of rejection asserted.

The examiner mailed a Final Office action to applicants on February 27, 2007. The examiner set forth a restriction requirement between claims 1-2, 4-6 and 8-14, as directed to the elected invention as elected by original presentation and claims 15-25, directed to a different invention and proceeded to examine again claim 1-2, 4-6 and 8-14. The potential for rejoinder of the withdrawn claims was noted. Claims 1-2, 4-6 and 8-14 were again rejected under 35 U.S.C. 112, first paragraph as lacking written description, and as lacking enablement in the specification. The examiner responded to applicants' arguments as to these rejections and withdrew the other rejections of record.

Applicants filed this petition on June 27, 2007, objecting to the finality of the Office action as premature. Applicants also filed a reply to the Final Office action concurrently and have since filed a Notice of Appeal on August 27, 2007. The amendment has not been considered by the examiner pending decision on this petition.

DISCUSSION

Applicants request withdrawal of the finality of the Office action of February 27, 2007, on the basis that the examiner for the first time argues that a mere mutant of the enzyme PGM2 lacks written description and enablement as opposed to previous arguments which were directed to coverage of non-PGM2 enzymes.

Applicants note that the original claims were directed to enzymes having a particular property and included the PGM2 enzyme as well as others. The May 22, 2006, Office action, as noted by applicants, includes a statement/argument by the examiner that "The results are not necessarily predictive of any other enzyme, wild or mutant, capable of catalyzing the conversion." (Other than the non-wild type PGM2 enzyme which was shown to catalyze the conversion.) Applicants interpret this as being directed to any wild type or mutant enzyme other than PGM2, either wild type or mutant or non-wild type. However, the argument can also be interpreted as being inclusive of wild type and mutant PGM2 enzymes. Applicants then note that the claims were limited to the PGM2 enzyme by incorporating claim 3 into claim 1 in response to this argument.

Applicants argue that since claim 3 already limited the enzyme to PGM2, the question of written description and enablement were before the examiner prior to the last Office action and that the examiner's maintaining the rejections under 35 U.S.C. 112, first paragraph, for lack of written description and enablement and making the action Final was in error.

As noted above, the examiner's argument/statement, as quoted by applicants from the May 22, 2006, Office action, covers both wild type and mutant types of enzymes, including PGM2. It does not exclude all PGM2 enzymes, but makes it clear that only the non-wild type PGM2 enzyme is clearly supported under 35 U.S.C. 112, first paragraph, in the specification.

DECISION

The petition is **DENIED**.

The application will be forwarded to the examiner for consideration of applicants' reply to the Final Office action filed June 27, 2007.

The time for filing an Appeal Brief or taking other appropriate action in response to the Notice of Appeal filed August 27, 2007, continues to run from that date and may be extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



Christopher Low
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